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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/364,099 07/30/99 CARETTA

R 07040.0041

EXAMINER

IM22/0824

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ART UNIT

PAPER NUMBER

1733

DATE MAILED:

08/24/01

Handwritten number: 9

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/364,099

Applicant(s)

CARLETTA, RENATO

Examiner

Geoffrey L. Knable

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-60 is/are pending in the application.
- 4a) Of the above claim(s) 31-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 43-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. Applicant's election with traverse of group II, claims 43-60 in Paper No. 8 is acknowledged. The traversal is on the ground(s) that there is no serious burden to examine both groups in the same application. This is not found persuasive because there would be a significant additional search and examination burden to examine claims to both the method and carcass in the same application, the different classifications providing evidence of the different considerations involved in examining each grouping.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 31-42 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 8.

3. Claims 43-60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to

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whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 43 recites the broad recitation "for tires", and the claim also recites "in particular for two wheeled vehicles" which is the narrower statement of the range/limitation. Claims 59 and 60 include similar language and are therefore indefinite for the same reasons.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 43, 59 and 60 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Iseki (US 5,419,384) or Alderfer (US 3,826,297).

Both Iseki and Alderfer disclose tires including carcass structures in "U-shaped" form and formed from successively laid strip sections as claimed. Beads with fillers are also clearly shown, these corresponding to the claimed annular reinforcing structures. As to the reference to two wheeled vehicles, as already noted, it is not clear whether this is a positive requirement of the claim. Even if it is, it is considered to have been obvious to apply the teachings of the references to any conventional tire including those for two wheeled vehicles, only the expected results being achieved.

7. Claims 43-49 and 56-60 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Frazier (US 3,240,250).

Frazier discloses tires including carcass structures in "U-shaped" form and formed from circumferentially successive strip sections as claimed. Beads with fillers are also clearly shown or certainly obvious from the depictions in the reference and the well known and conventional nature of using beads and fillers in tires, these corresponding to the claimed annular reinforcing structures. As to the reference to two wheeled vehicles, as already noted, it is not clear whether this is a positive requirement of the claim. Even if it is, it is considered to have been obvious to apply the teachings of the reference to any conventional tire including those for two wheeled vehicles, only the expected results being achieved.

The beads are also enclosed between alternating internal and external strip sections and include overlaps, etc. consistent with the requirements of claims 44-49 and 56-58, any differences being mere obvious optimizations of the basic teachings of the reference.

8. Claims 52-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frazier (US 3,240,250).

The particular strip section width as well as cord density would have been parameters whose optimum value would have been readily and routinely selected by the ordinary artisan dictated by the particular end use contemplated for the tire being built, only the expected results being achieved. Further, single width beads are known and conventional per se in this art and would have been obvious to use if desired to lower tire weight.

9. Claims 43, 48 and 50-60 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 928,702 to Caretta et al.

EP 928,702 to Caretta et al. discloses tires including carcass structures in "U-shaped" form and formed from successively laid strip sections as claimed. Beads with fillers are also clearly shown, these corresponding to the claimed annular reinforcing structures. As to the reference to two wheeled vehicles, as already noted, it is not clear whether this is a positive requirement of the claim. Even if it is, it is considered to have been obvious to apply the teachings of the reference to any conventional tire including those for two wheeled vehicles, only the expected results being achieved. The requirements of the noted dependent claims are also clearly shown or are certainly obvious from the disclosures of this reference.

10. **Note:** The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the

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application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA § 102(e)).

11. Claims 43, 48 and 50-60 are provisionally rejected under 35 U.S.C. 102(e) as being anticipated by copending Application No. 09/221603 which has a common inventor with the instant application.

Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future patenting of the copending application. This application apparently corresponds to the above noted EP '702 publication and thus is applicable against the present claims for the same reasons noted above.

This provisional rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

12. Claims 43, 48 and 50-60 are provisionally rejected under 35 U.S.C. 103(a) as being obvious over copending Application No. 09/221,603 which has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e) if

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patented. This provisional rejection under 35 U.S.C. 103(a) is based upon a presumption of future patenting of the conflicting application. This application apparently corresponds to the above noted EP '702 publication and thus is applicable against the present claims for the same reasons noted above.

This provisional rejection might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by a showing of a date of invention for the instant application prior to the effective U.S. filing date of the copending application under 37 CFR 1.131. For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

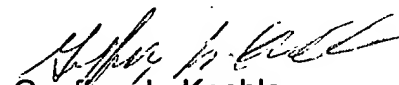
13. Although at present the other applications noted in the 10-28-1999 IDS are apparently not allowed and thus unlikely to present a conflict, applicant should also assure that none of these other applications, if allowed, would present potential rejections under 35 U.S.C. 102(e) and/or 103/102(e) and if so, to advance prosecution, appropriate response thereto should be provided if possible.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 703-308-2062. The examiner can normally be reached on M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael W. Ball can be reached on 703-308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7718 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.


Geoffrey L. Knable
Primary Examiner
Art Unit 1733

G. Knable
August 22, 2001